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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,634	09/19/2003	William B. Ardern II	ARD-101US	5073

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JANSSON SHUPE & MUNGER LTD.
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EXAMINER

HOGUE, GARY CHAPMAN

ART UNIT	PAPER NUMBER
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3611

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/664,634	Applicant(s) ARDERN, WILLIAM B.	
	Examiner Gary C. Hoge	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-33 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner:
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/26/07</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claim 33 is objected to because of the following informalities: on line 2, it appears that "polyethylene" has been misspelled. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. NOTE: There are two sets of rejections in this Office action, both based on Yochim (1,232,747). The first set treats the transparent cover 11 as the tri-panel binder clip sleeve. The second set treats the label underneath the cover as the tri-panel binder clip sleeve.
3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-12, 14, 15, 17-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yochim (1,232,747) in view of *Smead® Viewables®* and Sato (5,806,147).

See Fig. 1. Yochim discloses a tri-panel binder clip comprising first 3 and second 4 resilient jaw portions, a connecting spine portion 6 therebetween and an outer surface along each of the jaw and spine portions. A transparent sleeve element overlies the jaw portions and the spine. This transparent sleeve element protects a label, but the label is single-sided, rather than three-sided. *Smead® Viewables®* teaches that it was known in the art to provide a three-sided label for a tri-panel clip. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the single-sided label disclosed by Yochim with a three-sided label, as taught by *Smead® Viewables®*, in order to be able to read label information from

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the top, front and back. This three-sided label comprises a “tri-panel binder clip sleeve.” Further, Yochim does not disclose a handle secured to each of the jaw portions such that pressing together of the handles separates the jaw portions. Sato teaches that it was known in the art to attach a handle to the jaw portions of a tri-panel clip. It would have been obvious to one having ordinary skill in the art at the time the invention was made to attach handles to the jaw portions of the tri-panel clip disclosed by Yochim, as taught by Sato, in order to open the clip more easily.

Regarding claims 5, 17 and 30, adhesive comprises an extremely high-frictional engagement.

Regarding claims 6, 18 and 33, Yochim discloses the invention substantially as claimed, as set forth above. However, the label that comprises the tri-panel binder clip sleeve is made of paper. Because it is within the level of ordinary skill of a worker in the art to select from among known materials on the basis of their suitability for the fabrication of a given device, and since a person having ordinary skill in the art would know that polyethylene would be suitable for the fabrication of a label, it would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the label disclosed by Yochim, as modified by *Smead® Viewables®*, from polyethylene as a matter of choice in design, based on such factors as cost and availability of the materials to the designer, and because polyethylene labels are more durable than paper labels.

Regarding claim 12, the label disclosed by *Smead® Viewables®* is folded about two lines.

Regarding claim 20, the bends between the three panels constitute transition portions.

Regarding claim 21, the indicia on element 13 is raised from the clip 6 by virtue of the fact that it is printed on a paper having a thickness.

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yochim (1,232,747) in view of *Smead® Viewables®* and Sato (5,806,147), as applied to claim 7, above, and further in view of Bennett et al. (5,522,586).

Yochim, as modified, discloses the invention substantially as claimed, as set forth above. However, although the lable is folded in two places, it apparently does not include a perforation to assist in the folding. Bennett teaches (col. 2, lines 56-59) that it was known in the art to provide a perforation to assist in the folding of a sheet. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the label disclosed by Yochim, as modified, with a perforation, as taught by Bennett, in order to assist in folding the label.

Response to Amendment

6. The declarations under 37 CFR 1.132 filed January 26, 2007 is insufficient to overcome the rejection of claims based upon the prior art as set forth in the last Office action because the declarants' opinions on the ultimate legal issue is not evidence in the case. See MPEP § 716.0-1(c)(III). Further, all three experts have an interest in the outcome of the case.

Response to Arguments

7. Applicant's arguments filed January 26, 2007 have been fully considered but they are not persuasive.

Regarding Yochim, Applicant mentions the fact that this reference is 90 years old. But contentions that the reference patents are old are not impressive absent a showing that the art

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tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

Further, Applicant alleges that “Yochim’s bent sheet metal part is not a ‘binder clip’ as claimed.” But Yochim states that “the inherent resiliency of the sides 3 and 4 of the sheet 2 serve to grippingly engage a stencil or the like when inserted therebetween” (page 1, lines 69-75). Thus it is clear that Yochim discloses a binder clip, a binder clip which differs from Applicant’s claimed binder clip only in that it lacks handles secured to its jaw portions, a deficiency that is acknowledged in the rejection, above, and that is supplied by Sato, which clearly teaches the desirability of attaching handles to resilient jaw portions of a binder clip, in order to make it easier to separate the jaw portions.

Regarding Sato, Applicant notes that Sato “offers nothing with respect to association of indicia with a tri-panel sleeve affixed to a binder clip.” But Sato was cited only for its teaching that it was known in the art to attach handles to a binder clip, as mentioned above. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding VIEWABLES, Applicant states that this reference “has nothing whatsoever to do with binder clips of any kind.” But again, One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Yochim discloses a single strip label on a three-sided substrate. VIEWABLES teaches that it was known in the art to attach a three-sided label to a three-sided

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substrate, so that information can be conveyed from multiple viewing angles. This teaching suggests that it would be obvious to provide Yochim with a three-sided label to attach to its three-sided clip, so that information can be conveyed from multiple viewing angles.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

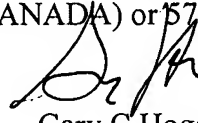
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gary C Hoge
Primary Examiner
Art Unit 3611

gch